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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/033,098	11/01/2001	Wayne Ellis Eccard	8765	7707
27752	7590	06/16/2004	EXAMINER	
THE PROCTER & GAMBLE COMPANY INTELLECTUAL PROPERTY DIVISION WINTON HILL TECHNICAL CENTER - BOX 161 6110 CENTER HILL AVENUE CINCINNATI, OH 45224			YU, GINA C	
			ART UNIT	PAPER NUMBER
			1617	

DATE MAILED: 06/16/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

10/033,098

Applicant(s)

ECCARD ET AL.

Examiner

Gina C. Yu

Art Unit

1617

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-200 is/are pending in the application.
- 4a) Of the above claim(s) 63-100 and 163-200 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-62, 101-162 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_.

## **DETAILED ACTION**

### ***Election/Restrictions***

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-62, 101-162, drawn to a composition, classified in class 510, subclass 108.
- II. Claims 63-100, 163-200, drawn to a method of applying active ingredients to skin or hair, classified in class 424, subclass 401, 402.

Inventions I and II are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case, the invention as claimed in group I can be used for purposes other than personal care, such as laundry soap sheet, hard-surface cleansing composition. See spec., p. 1, line 20 – p. 3, line 15. While applicants assert in specification that the present invention excludes personal care products designed for certain purposes, the claimed invention itself is a composition. The intended use or purposes recited in the specification or claims is not given any weight. See MPEP § 2111.02. Similarly, the delivery of active ingredients to skin or hair can be made with other types of cosmetic compositions, such as applying leave-on liquid or pasty compositions containing the active ingredients.

These inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter. The

inventions have acquired a separate status in the art as shown by their different classification, and searching and examining all pending claims would impose a serious burden on the examiner. Thus restriction requirement as indicated is proper.

During a telephone conversation with Jason Camp on May 7<sup>th</sup>, 2004 a provisional election was made with traverse to prosecute the invention of group I, claims 1-62 and claims 101-162. Affirmation of this election must be made by applicant in replying to this Office action. Claims 63-100, 163-200 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-62 and 101-162 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claims 1, 32, 101, and 132, the phrase "less than about" and "greater than about" in lines 3 and 4 render the claims vague and indefinite. There is nothing in the specification to indicate as to what arrange of viscosity is covered by "about". The metes and bounds of the scope of the claims are not ascertainable because it is not clear whether "less than about 15 cP" covers, for example, 14.5 cP or 20 cP. The limitation is confusing because what viscosities are covered by "greater than about 15 cP" or "greater than about 10 cP". The scope of the claims is even more confusing in claims 32 and 132, where applicants recite that one has a viscosity of "less than about

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15 cP" under the first Cold Water Insolubility Test, while it has a viscosity of "greater than about 15 cP" under the second Cold Water Insolubility Test. Should there be one viscosity value for both tests?

Similarly, the term "from about 1:1.6 to about 10:1" renders Claim 1 vague and indefinite because what is covered by "from about" 1.6 is uncertain. Does 1:1 or 1:2 meet the claim limitation? Claims 32, 101, and 132 are rejected for analogous reasons.

In claims 1, 32, 101, and 132, the term "an active ingredient comprising a surfactant" renders the claim vague and indefinite. Examiner views that one of ordinary skill in chemical art would understand that "an active ingredient" refers to a single compound. The limitation is confusing because it is not clear whether the ingredient itself is a surfactant or a composition comprising another active ingredient and a surfactant. For the examination purposes, examiner assumes that surfactant is the intended active ingredient in this case.

The remaining claims are rejected as depending on indefinite base claims.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-7, 9-38, 40-62, 101-107, 109-138, and 140-162 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Rowe (US 2226075).

Claim 1 recites a solid composition comprising 1) a polymer structurant having viscosity properties as recited and 2) a surfactant wherein the weight ratio of the surfactant to the polymer structurant is from about 1:1.6 to about 10:1, and wherein the composition disintegrates in water as described in the claim. The term "personal care" composition "for topical application to the hair or skin" are mere preambles which recited intended use or purposes and are not given patentable weight. See MPEP § 2111.02.

Rowe discloses sheet soap comprising polyvinyl alcohol (polymeric structurant) and glycerol (a plasticizing agent) in the weight ratio of the instant claims. See Examples I-V. See also p. 2, first column, lines 5 – 15. See instant claims 23, 24, 26-30, 54, 55, 57-61, 123, 124, 126-130, 154, 155, 157-161. See Example IV for the anionic surfactant, sulfated lauryl alcohol. See instant claims 25, 56, 125, and 156. The reference teaches that the layer of film has about 0.02 inch in thickness (0.51 mm). See *Id.*, at lines 58-60. See instant claim 7, 38, 107, and 138.

For claims 3, 34, 103, and 134, the structure implied by the process of making the composition is considered. However, the final product of the claimed invention is anticipated by the prior art, and thus the claimed process of making is not given patentable weight in this case. See In re Thorpe, 777 F.2d 695, 698, 227 USPQ 964, 966 (Fed. Cir. 1985) (citations omitted). Nevertheless, examiner notes that the prior art sheet soap is produced by mixing powdered soap with a 5 % aqueous solution of the polyvinyl alcohol, stirring and heating to 70 °C, and then drying the composition, which meet the claimed process steps. See p. 2, first column, lines 50 – 61. Thus the claimed

product-by-process is anticipated by the final product itself of the Rowe patent and the structure implied by the prior art process.

The viscosity limitation of the synthetic polymer structurant, polyvinyl alcohol in this case, is met since the physical property is inseparable from the compound. See instant claims 1, 2, 32, 33, 101, 102, 132, and 133. Similarly, while Rowe is silent as to the physical properties of the composition (i.e., Substrate Disintegration Test, Immersion Density, Calculated Density, basis weight, etc) as recited in claims 1, 4-6, 9-22, 32, 35-37, 40-53, 101, 104-106, 109-122, 132, 135-137, 140-153, these properties are inherent to the composition of the base claims. See page 2, first column, lines 61 – 67. For the textured surface limitation of instant claims 31, 62, 131, 162, see *Id.* at second column, lines 25 – 27.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 8, 39, 108, and 139 are rejected under 35 U.S.C. 103(a) as being unpatentable over Rowe, as applied to claims 1-7, 9-38, 40-62, 101-108, 109-138, and 140-162 above.

While the reference discloses that the sheet soap has thickness of about 0.2 inches (0.51 mm), the reference fails to teach the recited thickness the instant claims.

It is well settled in patent law that merely changing the dimensional size of a known device is an obvious variation of the art, absent any different performance in the claimed invention. See In Gardner v. TEC Systems, Inc., 725 F.2d 1338, 220 USPQ 777 (Fed. Cir. 1984), cert. denied, 469 U.S. 830, 225 USPQ 232 (1984). In this case, the claimed composition has different dimensional size with no criticality. The Rowe reference in fact teaches that the dimensional size is related to the supply amount of soap needed for the wash. See p. 2, first column, lines 67-70.

Given the teaching of the Rowe sheet soap having 0.51 mm thickness, making a sheet soap of 1.5 –7 mm thickness would have been obvious to one of ordinary skill in the art. It would have been obvious to the skilled artisan to make a thicker sheet soap as motivated by Rowe because of the expectation of successfully producing more supply of soap per sheet.

### ***Conclusion***

No claims are allowed.

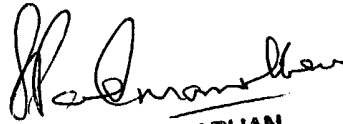
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gina C. Yu whose telephone number is 571-272-0635. The examiner can normally be reached on Monday through Friday, from 8:30 AM until 6:00 PM..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sreeni Padmanabhan can be reached on 571-272-0629. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.



Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Gina Yu  
Patent Examiner



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